Paper No. 9
RFC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 4/6/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re National Commercial Corporation

_____

Serial No. 75/341,967

_____

Frank P. Presta of Nixon & Vanderhye P.C. for National Commercial Corporation.

Stacey Johnson, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

_____

Before Simms, Cissel and Hairston, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 15, 1997, applicant filed the above-referenced application to register the mark "COUCHWORKS" on the Principal Register for "upholstered furniture," in Class 20. The basis for the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce with these products.

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's mark, if used in connection with upholstered furniture, would so resemble the mark "THE SOFA WORKS" and the mark shown below,

which are registered[1] for "retail furniture store services" and for "upholstered furniture, dual sleep sofas," that confusion would be likely. The Examining Attorney reasoned that the terms "couch" and "sofa" have the same meaning in relation to the goods with which applicant intends to use its mark, in that both are names which refer to the same piece of furniture, so applicant's mark is similar to the registered marks, and the goods specified in the application are identical to those named in the registrations.

Applicant responded by arguing that confusion would not be likely because applicant's mark is different from the registered marks in appearance and in sound. Further,

[1] Reg. Nos. 1, 203,594 and 1,248,373, issued to Waterbury Mattress Co. on August 3, 1982 and Aug. 16, 1983, respectively. Both are now owned by Ohio Mattress Co. Licensing and Components Group. Combined affidavit under Sections 8 and 15 were filed with respect to each registration. Each registration contains a disclaimer of the word "sofa" apart for the mark as shown.

applicant included copies of 18 third-party trademark registrations for marks which include the component term "WORKS" where the goods specified in the registration include cabinets, counters, or items of furniture. Applicant argued that because the word "WORKS" is commonly used in registered marks for furniture and related goods and services, the differences between applicant's mark "COUCHWORKS" and the cited registered marks, which both include "THE SOFA WORKS," would be sufficient to preclude any likelihood of confusion.

The Examining Attorney was not persuaded by applicant's arguments, however, and in his second Office Action, he made the refusal to register under Section 2(d) of the Act final.

In support of the refusal to register, the Examining Attorney made of record dictionary definitions which establish that "couch" and "sofa" are virtually synonymous. Also made of record with the final refusal were excerpts from published articles, retrieved from the Nexis® database, which show the terms used interchangeably.

Applicant filed a notice of appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

The sole issue on appeal is whether confusion would be likely if applicant's mark "COUCHWORKS" were used in

connection with upholstered furniture in view of the registered word mark "THE SOFA WORKS" and the design mark incorporating the same words, both of which are registered for upholstered furniture and also for retail furniture store services.

The Examining Attorney cited a number of cases for the basic principles of trademark law which apply to the case at hand. To begin with, we must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements may be sufficient to find confusion likely. In re Mack, 197 USPQ 755 (TTAB 1997). The test is not whether the marks can be distinguished when they are compared to each other side by side, but rather whether the marks create similar overall commercial impressions. Visual Information Institute, Inc. v. Vicon Industries Inc., 209 USPQ 179 (TTAB 1980). We must look to the likely recollection of the average purchaser, who normally retains a general, rather than specific, impression of a trademark. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

If we conclude that the marks are similar, then we must compare the goods and/or services to determine if they are

related or if the activities surrounding their marketing are such that confusion as to source is likely. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

When we apply these principles to the case before us, we must conclude that confusion is likely. Although not identical, the marks create similar commercial impressions because the connotation of each is the same. The primary reason for this is the synonymous nature of the words "SOFA" and "COUCH," both of which are generic terms in connection with the goods in the registrations and the goods specified in this application. Contrary to applicant's argument, the addition of the article "THE" in the registered marks and the fact that the component words in applicant's mark have been combined without putting a space between them do not result in marks which would be readily distinguished, even if they were compared on a side-by-side basis, which, as noted above, is not the test anyway.

As to the second part of the test for likelihood of confusion, there can be no question that the goods with which applicant intends to use its mark are identical to the goods specified in the cited registrations. Additionally, each of the cited registrations lists furniture store services, which are plainly related to the products with

which applicant intends to used its mark. The fact that both cited registrations include both upholstered furniture and furniture store services shows that these goods are related to the store services which are involved in selling them.

Applicant's brief cites no authority to the contrary. In fact, it cites no authority at all. Instead, applicant's primary argument seems to center around the third-party registrations it submitted with its response to the first Office Action. Applicant contends that these registrations show the common "use" of the word "WORKS" as a suffix in the listed registrations for marks for furniture and related goods and services, and that consideration of this common use of "WORKS" makes it apparent that differences between applicant's mark and the cited registered marks should be sufficient to preclude any likelihood of confusion.

As the Examining Attorney points out, however, the third-party registrations, by themselves, do not have much relevance to the resolution of the issue of likelihood of confusion. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Such registrations are not evidence of what happens in the marketplace. They do not establish that the public is familiar with the use of those marks because they are not evidence that the marks are in use. National Aeronautics

and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975).

In summary, the record in this application plainly establishes that confusion is likely. We have no doubt that if applicant's mark were used on the goods specified in the application, confusion would be likely in view of the two cited registered marks. Even if we had doubt as to this conclusion, however, any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant, who has a legal duty to select a mark which is totally dissimilar to trademarks already being used in this field. Burrows Wellcome Co. v. Warner-Lambert Co., 203 USPQ 191 (TTAB 1979).

DECISION: The refusal to register is affirmed.

R. L. Simms

R. F. Cissel

P. T. Hairston
Administrative Trademark Judges
Trademark Trial & Appeal Board